

Application No. 09/825,470
Amendment dated September 16, 2004
Reply to the Final Office Action of June 16, 2004

REMARKS

Applicant has amended claims 1-2, 4-6, 9, 11, 13-14, 16 and 20-22; added claim 27 and cancelled claims 3, 10 and 23 . Claims 1-2, 4-9, 11-22, 24-27 are now pending in this application.

In the Final Office Action dated June 16, 2004, the Examiner has withdrawn the rejection under 35 U.S.C. §112, second paragraph to Claim 21. In addition, the Examiner has withdrawn the rejection under 35 U.S.C. §101 to Claims 1-15. Applicant wishes to thank the Examiner for the withdrawals of the rejections and appreciates the Examiner's efforts in this regard .

The Examiner has rejected Claims 1-26 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. The Examiner states that the claims contain subject matter, which were not described in the specification in such a way as to enable one skilled in the art to which it pertains to make and/or use the invention.

In addition, the Examiner has rejected Claims 1-15 under 35 U.S.C. §103 as being unpatentable over Heckman et al. (U.S. Patent 5,875,431) in view of Martin (U.S. Patent no. 6,330,547).

The undersigned has reviewed the June 16, 2004 Final Office Action and respectfully traverses all rejections for the reasons set forth herein.

Applicant respectfully submits that no new matter has been added, that the amendments have been made in good faith and that claims 1-2, 4-9, 11-22, 24-27 are in proper form for allowance.

a. 35 U.S.C. § 112, first pagrapah

The Examiner has rejected Claims 1-26 under 35 U.S.C. §112, first pagraph, as failing to comply with the enablement requirement. The Examiner states that the claims contain subject matter, which were not described in the specification in such a sway as to enable one skilled in

the art to which it pertains to make and/or use the invention. See Office Action, p. 2. Applicant respectfully traverses this rejection.

Applicant respectfully points out that in determining whether “the claims at issue [are] sufficiently precise to permit a potential competitor to determine whether or not he is infringing,”ⁱ the Federal Circuit has not held that a claim is indefinite merely because it poses a difficult issue of claim construction.ⁱⁱ The Federal Circuit also has not insisted that claims be plain on their face in order to avoid condemnation for indefiniteness; rather, what the Federal Circuit has asked is that the claims be amenable to construction, however difficult that task may be.ⁱⁱⁱ

Case law also teaches us that claim interpretation begins with the language of the claims.^{iv} The general rule is that terms in the claim are to be given their ordinary and accustomed meaning^v. In determining the proper meaning of the claims, it is correct to “first consider the so-called intrinsic evidence, i.e. the claims, the written description, and if in evidence, the prosecution history.”^{vi}

Applicant respectfully points out that the specification and the claims use terms widely used and understood in the industry, and that a person schooled in the arts would not have any difficulty ascertaining whether they generated a risk quotient succinctly defined within the claim itself as a scaled numeric or alphanumeric value. However, in order to clarify the meaning of the claims, the Applicant has amended to claims to remove the term “risk quotient” and continue with the underlying terms provided, namely “scaled numeric and alphanumeric value”. In addition, the Applicant has amended the claims so that they refer to “predefined” criteria instead of “risk quotient” criteria (as per p. 11 line 21).

Applicant respectfully suggest that all terms utilized in the amended are sufficiently defined according to their ordinary and accustomed meaning and through intrinsic reference in the specification. The language of the specification defines a risk quotient as “a scaled numeric or alphanumeric value indicative of an amount of a relative amount of legal risk associated with a legal action” (p.7 lines 21-22). Applicant respectfully submits that it is not apparent why the Examiner has difficulty with the ordinary and accustomed meaning of terms such as “scaled”,

“numeric” or “alphanumeric”, however, Applicant is willing to provide readily available definitions for such terms from Webster’s Unabridged Dictionary:

Scale: a system of grouping or classifying in a series of steps or degrees according to a standard of relative size, amount, importance, perfection, etc. (Applicant suggests the present claims utilize a definition of the classify in a series of degrees according to a standard of importance.)

Numeric: of, or having the nature of, a number.

Alphanumeric: having or using both alphabetic and numerical symbols.

Applicant suggests that another person skilled in the arts will be able to duplicate the invention according to the plain meaning of the claims. A scaled value is a commonly used artifact. Calculation of a scaled numeric or alphanumeric value is well known and practiced throughout many industries. Scaled numeric and alphanumeric values are calculated and utilized in numerous instances and easily ascertained applications. For example, scaled numeric or alphanumeric values are calculated for credit ratings (i.e. Moody’s rating); consumer satisfaction ratings, performance ratings, movie ratings, even beach weather ratings.

The present invention is not limited to any one method or algorithm for the generation of such a scaled value. Many techniques and methods can be adapted for the generation of a scaled value based upon the information relating to legal action. Applicant respectfully suggests that the present invention is not limited to any one algorithm or method for ascertaining the scaled numeric or alphanumeric value, and that generating such a person practicing the present invention is free to generate a value via objective or subjective means.

In addition, considering the intrinsic evidence, in order to facilitate understanding of the present invention, Applicant has included in the specification an exemplary step-by-step process that explains how a scaled numeric or alphanumeric value can be calculated. On page 12 lines 2-14 the specification provides exemplary steps for generating a scaled value, including:

- a) assigning a numerical value representative of the risk associated with a particular piece of information (p. 12 lines 2-3);

- b) assigning a weight to a risk assessment factor to which the information is assigned (p. 12 lines 8-10); and
- c) multiplying the numerical value times the weight to obtain a risk factor (p. 13 lines 10-13)
- d) summing up multiple risk factors to obtain a risk quotient (scaled alphanumerical value) (p. 13 lines 13-14).

The specification therefore explicitly states one exemplary way to implement the invent, which includes multiplying (an assigned numerical value representative of risk associated with a piece of information) x (a numerical weight of a risk assessment factor to which the information is assigned) and summing up the results for multiple pieces of information to obtain a risk quotient (scaled numerical or alphanumerical value).

In addition, at p. 12 lines 15-27, the specification lays out a specific example of how a scaled numerical or alphanumerical value may be calculated. The example on p. 12 lines 15-27 specifically details that a risk assessment weight can be subjective to the client using the present invention, as can be a numerical value representative of the risk associated with a particular piece of information. A risk assessment factor can be anything that is important to the client and relates to the client's status as party to a litigation or an amicus curiae.

Applicant therefore respectfully asserts that "the claims at issue [are] sufficiently precise to permit a potential competitor to determine whether or not he is infringing."¹ A scaled value is a basic artifact widely understood in the industry and succinctly described in the specification. Someone skilled in the arts will understand how to generate a scaled value and know whether or not they have generated a scaled value based upon information related to a legal action and data relating to the person's involvement in a legal action based upon said person's status comprising at least one of: a party to a litigation, or arbitration; or a prospective party to a litigation or arbitration; or an amicus of the court in a pending litigation.

Similarly, one skilled in the art will not require undue experimentation to implement the methods described on a computer processing system.

b. **35 U.S.C. §103**

The Examiner has rejected Claims 1-15 under 35 U.S.C. §103 as being unpatentable over Heckman et al. (U.S. Patent 5,875,431) in view of Martin (U.S. Patent no. 6,330,547).

Applicant respectfully traverses this rejection.

In order to establish a case of obviousness, the Examiner must meet three basic criteria. First, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the references' teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure. MPEP 706.02(j), citing In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Further a *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

The Applicant respectfully suggests that the prior art provided by the Examiner has not met any of the three criteria. No motivation has been provided to modify either Martin (U.S. Patent No. 6,330,547) or Heckman (U.S. Patent No. 5,875,431), nor has a reasonable expectation

¹ id

been shown that a modification of Heckman or Martin would yield the present invention, nor does the prior art teach or suggest all of the claim limitations.

On page 5, second paragraph, the Examiner has indicated that Martin discloses a computer implemented method ... for managing risk related to a legal action . It appears that the Examiner is referring to Heckman and the Applicant will proceed accordingly, if the Examiner did mean to discuss Martin at that point, then the Applicant would request clarification on this issue.

Heckman is directed to a closed loop legal strategic planning system for outlining objectives and tasks and their associated timing. Three closed loop control systems a) monitor legal costs, b) monitor attainment of objectives and c) control deliverables derived from completion of tasks (col. 1 lines 21-33). The Heckman invention is directed to maximizing the likelihood of a desired legal outcome in connection with a legal action and control costs (col. 4 lines 63-68). Essentially, Heckman describes case management software. A fundamental aspect of the invention without which implementation of the invention would be impracticable is directed to a strategic plan cost management strategy and bench marking elements (col. 15 40-49).

The system of Heckman receives three kinds of data: initial data directed to the administrative and demographic particulars of each law firm subscribed to the system, case specific data relating to the present case, and case outcome feedback data from which future litigation/legal templates might be drawn (col. 16 lines 16- 21). Heckman describes how the

three kinds of data can be applied to attain the objectives of the Heckman system (monitor legal costs, monitor attainment of objectives and control deliverables derived from completion of tasks).

Heckman does not describe or imply the generation of a scaled numerical value indicative of an amount of risk associated with a legal action, or a sum of such values that can indicate an amount of risk an entity may be exposed to the relates to legal actions.

Martin is directed to methods deciding whether to make a loan, using intellectual property as collateral for the loan. Martin “relates to a computer-assisted method and system for ascertaining and enhancing the creditworthiness of and establishing a value for intellectual property assets used as collateral for loans made primarily to emerging companies” (co. 2 lines 11-15). The method of Martin is divided into two stages. The first stage includes validating basic information about proposed collateral, such as ownership of the collateral, transferability and viability. The second stage involves calculation of an asset liquidation value (purchase price) for the collateral (see col. 2 lines 34-50).

The first stage is further broken down into several substages. In pertinent part, the Examiner has noted the second substage which provides that a determination is to be made as to whether intellectual property rights (for the collateral) are active and enforceable and addresses issues such as whether pertinent fees have been paid. The third substage provides for an examination of whether an asset is to be marketed in a highly competitive sector where there has

been a history of litigation between competitors or other litigation risk arising from product or process liability (col. 9 lines 47-50).

In the second stage, the Examiner points out that a mathematical slope for a depreciation linearity is utilized to indicate an order of depreciation for an asset and the life of an intellectual property asset. Martin indicates that the life of an intellectual property can be based upon a comparative analysis of the market in which the asset must compete. Factors that can be considered in determining such life can include: product life cycle, terms of trade barriers or government regulations and a time period before a generic product is introduced.

As indicated above, in order for the Examiner to establish a case of obviousness, she must demonstrate that the prior art references describe or suggest all of the claimed limitations of the present invention. The Applicant respectfully submits that this demonstration has not been met. Neither Heckman nor Martin describes or implies generation of a report that includes a scaled numerical or alpha-numerical value that is indicative of an amount of risk associated with a legal action, nor inclusion in the report of the portion of structured information upon which the scaled numeric or alphanumeric number is based.

The present invention specifically refers to four types of risk: legal risk, financial risk, regulatory risk and reputational risk. The present invention teaches a tool that can assist a decisionmaker by providing a simple measure (numerical scale) of an aggregate amount these risks that is associated with a legal action. In addition, the present invention provides support for the simple measure by including in the report information upon which the measure is based.

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Heckman provides a system and method directed to case management, not overall risk evaluation of a legal action. Heckman may be useful in managing minutiae involved in legal cases, but cannot provide a quick indication of what a level of risk is that is associated with a legal action and also provide back up in the form of the information utilized to generate the indication of the level of risk.

Martin does not help. Martin is directed to a specific issue, collateral that may be used for a loan. Martin does not describe or imply denotation of a scaled numerical value indicative of an aggregate of risk associated with a legal action.

Even if Heckman and Martin described or implied all of the elements of the claimed invention, no motivation has been shown to combine case management software with methods and apparatus for deciding whether to make a loan using intangible assets as collateral. These are disparate functions with no motivation for overlap.

Finally, no illustration has been made that even if the case management software of Heckman were combined with collateral assessment system of Martin a reasonable expectation of successfully generating a scaled alphanumerical value indicative of an amount of aggregate risk associated with a legal action would result and also include information upon which the scaled numerical value has been based.

Therefore, Applicant respectfully submits that the Examiner has not established a case for obviousness and the present claims should be allowed.

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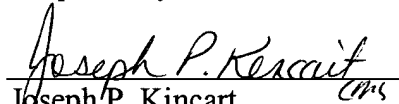
CONCLUSION

For the foregoing reasons, the undersigned respectfully submits that claims 1-2, 4-9, 11-22, 24-27, as amended, are in condition for allowance, and such allowance is courteously urged.

Please charge any fees due in connection with this Amendment to Deposit Account No. 50-0521.

Respectfully submitted,

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ⁱ Morton Int'l, Inc. v. Cardinal Chem. Co., 5F.3d 1464, 1470, 28 USPQ 2d 1190, 1195 (Fed. Cir. 1993)

ⁱⁱ Exxon Research & Eng'g Co. v. United States, 265 F.3d 1371, 60 USPQ 2d 1272, 1276 (Fed. Cir. 2001)

ⁱⁱⁱ Id.

^{iv} Renishaw PLC v. Marposs Societa Per Azioni, 158 F.3d 1243, 48USPQ 2d 1545, 1548 (Fed. Cir. 1997); Bell Communications Research, Inc. V. Vitalink Communications Corp., 55F.3d 1568, 1572, 40 USPQ2d 1816, 1819 (Fed. Cir.1995)

^v see Renishaw PLC v. Marposs Societa Per Azioni, 158 F.3d 1243, 1248, 48 USPQ 2d 1117, 1120 (Fed. Cir. 1998) ; York Prods., Inc. v. Central Tractor Farm & Family Ctr., 99. F3d 1568, 1572, 40 USPQ 2d 1619, 1622 (Fed. Cir. 1996)

^{vi} Digital Biometrics, Inc., 149 F3d 1335, 1347, 47 USPQ 2d 1418, 1424 (Fed. Cir. 1998)